

June 6, 2006

VIA U.S. EXPRESS MAIL

United States Patent and Trademark Office
Trademark Trial and Appeal Board
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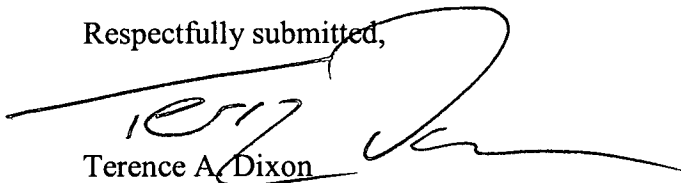
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Re: *Laurice El Badry Rahme Ltd. v. Asprey Holdings Limited Corp.*
Opposition No. 91167945

Dear Sir or Madam:

Enclosed for filing in this matter is Applicant/Petitioner's Reply Brief on Its Motion for Summary Judgment on Counterclaim for Cancellation.

Respectfully submitted,



Terence A. Dixon

Enclosures

cc: George Gottlieb, Esq. (w/encl)



06-06-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

LAURICE EL BADRY RAHME LTD.
(dba LAURICE & CO),

Opposer/Registrant,

v.

ASPREY HOLDINGS LIMITED CORP.,

Applicant/Petitioner.

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Opposition. No. 91167945

**APPLICANT/PETITIONER'S REPLY BRIEF ON ITS MOTION
SUMMARY JUDGMENT ON COUNTERCLAIM FOR CANCELLATION**

On June 2, 2006, Opposer/Registrant, Laurice El Badry Rahme Ltd. (dba Laurice & Co.) ("Registrant"), filed with this Board a voluntary surrender for cancellation of Registration No. 2,742,675, which is the subject of the counterclaim for cancellation asserted in this proceeding by Applicant/Petitioner, Asprey Holdings Limited Corp. ("Petitioner"). In that document and an accompanying Memorandum in Opposition to Applicant/Petitioner's Motion for Summary Judgment, Registrant claims that its filing of a voluntary surrender of the registration renders "moot" Petitioner's counterclaim for cancellation and the pending motion for summary judgment.

However, the filing of such a voluntary surrender was procedurally inappropriate in light of the Board's order of April 24, 2006 suspending proceedings pending the motion for summary judgment and prohibiting the parties from submitting any papers not relevant to that motion. Moreover, insofar as Registrant filed its voluntary surrender without the Petitioner's consent, it is

well established that judgment should be entered against Registrant with respect to Petitioner's counterclaim as a matter of law. Thus, even if the Board were to overlook the fact that Registrant's request for voluntary cancellation was filed in violation of the Board's order, the filing of such a voluntary surrender does not somehow render the counterclaim "moot." To the contrary, Petitioner is clearly entitled to judgment with prejudice on its counterclaim that the registration be cancelled for fraud.

We have no doubt that Respondent would prefer to simply walk away from its fraudulent registration and pretend like it never existed. However, the law is otherwise.

Argument

On April 12, 2006, Petitioner filed a motion for summary judgment on its counterclaim for cancellation of Registration No. 2,742,675 on the grounds that Registrant had admitted all the predicate facts required to support Petitioner's assertion that Registrant had procured the registration through fraud on the Trademark Office. Rather than respond to the merits of that motion, however, Respondent instead filed a request to voluntarily surrender the registration for cancellation pursuant to Section 7(e) of the Trademark Act.¹ In its April 24th order suspending proceedings, however, the Board expressly stated that "[a]ny paper filed during the pendency of this motion which is not relevant thereto will be given no consideration." *See* 37 C.F.R. § 2.127(d); TBMP § 510.03 ("Once the Board has suspended proceedings in a case, pending

¹ In its Memorandum in Opposition to Applicant/Petitioner's Motion for Summary Judgment Respondent insists that the registration is not being surrendered because a fraud was committed during the procurement of the registration. Despite its adamant denial, however, it is plain that Respondent has admitted all the requisite elements of Petitioner's fraud claim in Respondent's Answer to Counterclaim for Cancellation as Petitioner has demonstrated in its Motion and Brief for Summary Judgment.

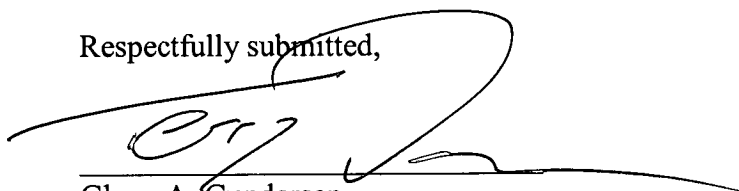
determination of a potentially dispositive motion, no party should file any paper that is not germane to the motion"). The voluntary cancellation is clearly not responsive to the motion for summary judgment or indeed directly relevant to that motion. In particular, as shown below, the filing of such a request does not moot the motion for summary judgment. *Compare The Nestle Co. v. Joyva Corp.*, 227 U.S.P.Q. 477, 478 n.4 (TTAB 1985) (filing of cross-motion for summary judgment is appropriate following suspension and will be considered). As such, the request for voluntary surrender should not even be considered by the Board.

Even if the Board concludes that Respondent's filing of the voluntary surrender did not violate its April 24th order or is somehow germane to the motion for summary judgment, however, the filing of that request does not render "moot" the counterclaim for cancellation or the pending motion for summary judgment as Respondent claims. Trademark Rule 2.134(a) expressly states that "[a]fter the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(e) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent." 37 CFR § 2.134(a); *see also* TBMP § 602.02 (and cases cited therein). Respondent did not obtain -- or even seek -- Petitioner's consent to its voluntary cancellation request. As such, Respondent may not simply voluntarily surrender the registration under Section 7(e) and in so doing somehow obviate petitioner's counterclaim. Instead, Petitioner is clearly entitled to an award of judgment with prejudice (with all the collateral estoppel effect to which such a judgment is entitled) on its counterclaim. Far from mooting the counterclaim and the motion for summary judgment, therefore, Respondent's action provides further justification for awarding judgment to Petitioner.

Conclusion

For the reasons set forth herein and in Petitioner's Motion and Brief for Summary Judgment, the Board should reject Respondent's request for voluntary cancellation and proceed to consider and grant Petitioner's motion for summary judgment. Alternatively, the Board should grant judgment with prejudice to Petitioner on its counterclaim on the basis of Respondent's filing of a voluntary submission for cancellation without Petitioner's consent and cancel Registration No. 2,742,675 on that basis.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Gundersen', is written over a horizontal line.

Glenn A. Gundersen

Terence A. Dixon

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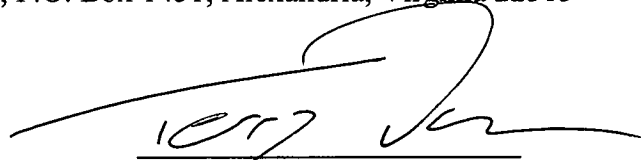
Attorneys for Applicant/Petitioner
ASPREY HOLDINGS LIMITED CORP.

Dated: June 6, 2006

Certificate of Mailing by Express Mail

I hereby certify that Applicant/Petitioner's Reply Brief for Summary Judgment on Counterclaim for Cancellation is being deposited with the United States Postal Service as Express Mail, Post Office to Addressee, in an envelope addressed to: Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, Virginia 22313-1451, on June 6, 2006.

Terence A. Dixon
Person Signing Certificate

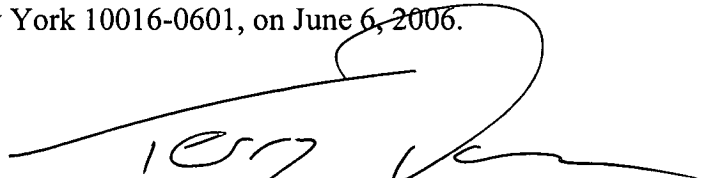

Signature

June 6, 2006
Date of Signature

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant/Petitioner's Reply Brief for Summary Judgment on Counterclaim for Cancellation has been duly served by mailing such copy first class, postage prepaid, to George Gottlieb, Esq., GOTTLIEB, RACKMAN & REISMAN, P.C., 270 Madison Avenue, New York, New York 10016-0601, on June 6, 2006.


Terence A. Dixon